

**Amendment and Response under 37 C.F.R. 1.116**

Applicant: Thomas A. Saksa

Serial No.: 09/940,363

Filed: August 27, 2001

Docket No.: 10011180-1

Title: MEASUREMENT AND MARKING DEVICE

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**REMARKS**

The following remarks are made in response to the Final Office Action mailed October 22, 2003, in which claims 1, 2, 4-9, 12-16, 18, 20-23, and 27-33 were rejected. With this Amendment, claims 14-16, 18, 20, and 21 have been cancelled without prejudice, claims 1 and 22 have been amended to clarify Applicant's invention, and claims 34 and 35 have been added. Claims 1, 2, 4-9, 12, 13, 22, 23, and 27-35, therefore, remain pending in the application and are presented for reconsideration and allowance.

**Claim Rejections under 35 U.S.C. § 103**

Claims 1, 2, 4-9, 12-16, 18, 20-23, and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Wiklof et al. U.S. Patent No. 5,825,995 in view of the Coulter et al. U.S. Patent No. 4,233,749.

With this Amendment, claims 14-16, 18, 20, and 21 have been cancelled without prejudice. The rejection of claims 14-16, 18, 20, and 21 under 35 U.S.C. 103(a), therefore, is rendered moot.

With this Amendment, independent claim 1 has been amended to clarify that the controller is adapted to store the position of the housing relative to the object as a measurement of the object when the input of the user interface is operated by the user, and independent claim 22 has been amended to clarify that locating a feature of the first object includes receiving user input at the feature of the first object and storing the position of the housing at the feature of the first object as the measurement of the first object with a controller mounted in the housing.

With respect to the Wiklof et al. and Coulter et al. patents, Applicant submits that neither of these patents, individually or in combination, teach or suggest a measurement and marking device, as claimed in independent claim 1, wherein a controller is adapted to store a position of the housing relative to an object as a measurement of the object when an input of the user interface is operated by a user, nor a method of transferring a measurement of a first object to a second object, as claimed in independent claim 22, including receiving user input at a feature of the first object and storing a position of the housing at the feature of the first object as the measurement of the first object with a controller mounted in the housing.

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For example, the Coulter et al. patent discloses an apparatus for marking preselected measurements on an object (col. 2, lines 22-23). The apparatus of the Coulter et al. patent contemplates use when measurement only is desired without marking and such measurement is to be read out on display 32 (col. 6, lines 30-32). The apparatus of the Coulter et al. patent, however, does not receive user input at a user interface, such as keyboard 28, when such a measurement is made. More specifically, none of the keys 36 of keyboard 28 of the apparatus of the Coulter et al. patent is operated as an input by a user when the measurement is made. The apparatus of the Coulter et al. patent, therefore, does not store a position of the housing relative to or at a feature of an object as a measurement of the object when an input of the user interface is operated, as claimed in independent claims 1 and 22.

In view of the above, Applicant submits that independent claims 1 and 22 are patentably distinct from the Wiklof et al. and Coulter et al. patents and, therefore, in a condition for allowance. Furthermore, as dependent claims 2, 4-9, 12, 13, 30, 31, and 34 further define patentably distinct claim 1, and dependent claims 23, 27-29, 32, 33, and 35 further define patentably distinct claim 22, Applicant submits that dependent claims 2, 4-9, 12, 13, 23, and 27-35 are also in a condition for allowance. Applicant, therefore, respectfully requests that the rejection of claims 1, 2, 4-9, 12-16, 18, 20-23, and 27-33 under 35 U.S.C. 103(a) be reconsidered and withdrawn and that claims 1, 2, 4-9, 12, 13, 22, 23, and 27-35 be allowed.

**CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 1, 2, 4-9, 12, 13, 22, 23, and 27-35 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Any inquiry regarding this Amendment and Response should be directed to either Gregg W. Wisdom at Telephone No. (360) 212-8052, Facsimile No. (360) 212-3060 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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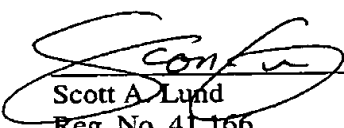
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**CERTIFICATE UNDER 37 C.F.R. 1.8:** The undersigned hereby certifies that this paper or papers, as described herein, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 872-9306 on this 9<sup>TH</sup> day of December, 2003.

By   
Name: Scott A. Lund